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28101	7590	10/02/2003	EXAMINER	
VAN DYKE, GARDNER, LINN AND BURKHART, LLP 2851 CHARLEVOIX DRIVE, S.E. P.O. BOX 888695 GRAND RAPIDS, MI 49588-8695				WACHTEL, ALEXIS A
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/647,209
Filing Date: September 27, 2000
Appellant(s): BOGE ET AL.

Matthew L. Goska
For Appellant

MAILED
OCT 02 2003
GROUP 1700

EXAMINER'S ANSWER

This is in response to Appellant's brief on appeal filed July 7th, 2003.

(1) Related Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After First Action

The Appellant's statement of the status of amendments after first office action rejection is correct.

(5) Summary of Invention

The summary of the invention contained in the brief is correct.

(6) Issues

The Appellant's statement of the issues in the brief is substantially correct.

(7) Groupings of Claims

The Appellant's statement of groupings of claims in the brief is correct.

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal:

US 4,866,905 to Bihy
DE 3713108
EP 0 795 424 A1

(10) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

- a. Claims 1,2 and 8-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,866,905 to Bihy et al.

The limitations relating to the design of the specifically claimed graphical markings designs on the surface of the claimed mineral wool sheet are given no patentable weight as they do not structurally affect the final product, and since they do not contribute to the function of the claimed product over and above what is taught in the applied art for *such markings*. Examiner does give weight to the fact that Applicant's claimed article has either functional or decorative indicia located thereon. Appropriately applied prior art must have either decorative or functional indicia means located on the Applicant's claimed article.

Bihy et al discloses a mineral fiber material available in roll form (Col 2, lines 44-46) which meets the "insulation material sheet" limitations of claims 1,2 and 26. To facilitate guidance of the cut for separating the portions of the mineral fiber strip, markings can be provided on one side of said mineral fiber strip (Abstract).

Bihy et al as set forth teaches the claimed invention except for the specific graphic design. Since Bihy et al as set forth above teaches to provide graphics on the mineral fiber material for the same function as instantly claimed, i.e. cut guidance, it would have been a matter of obvious design choice to have provided any specific functional design motivated by the desire to provide a user with convenient instructions or improved product aesthetics.

b. Claims 1,2 and 8-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3713108A.

As set forth above with respect to Bihy et al, the limitations relating to the design of the specifically claimed graphical marked designs on the surface of the claimed

mineral wool sheet are given no patentable weight as they do not materially affect the final product. Also, as above, the Examiner does give weight to the fact that Applicant's claimed article has either functional or decorative indicia located thereon. Appropriately applied prior art must have either decorative or functional indicia means located on the Applicant's claimed article.

DE 3713108A discloses a mineral fiber web (English Abstract) which meets the "insulation material sheet" limitations of claims 1 and 2. In addition a method is disclosed for applying marking lines to a mineral fiber web for guiding cuts made to said mineral fiber web (English Abstract).

DE 3713108A as set forth teaches the claimed invention including the function of the claimed markings but is silent to the specific graphic design claimed instantly. Since DE 3713108A as set forth above teaches to provide functional graphics on the mineral fiber material, it would have been a matter of obvious design choice to have provided any specific such design meeting the disclosed function motivated by the desire to provide a user with convenient instructions or improved product aesthetics.

c. Claims 1,2 and 8-35 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 795424 A1.

As set forth above with respect to Bihy et al, the limitations relating to the design of the specifically claimed graphical marked designs on the surface of the claimed mineral wool sheet are given no patentable weight as they do not materially affect the final product. Also, as above, the Examiner does give weight to the fact that Applicant's claimed article has either functional or decorative indicia located thereon. Appropriately

applied prior art must have either decorative or functional indicia means located on the Applicant's claimed article.

EP 795424 A1 discloses as known, boards made of mineral fibers (English Abstract) which meets the "insulation material sheet" limitations of claims 1 and 2. In addition, EP 795424 A1 discloses applying markings to a mineral fiber material for guiding cuts made to said mineral fiber material (English Abstract).

EP 795424 A1 as set forth teaches the claimed invention including the function of the claimed markings but is silent to the specific graphic design claimed instantly. Since EP 795424 A1 as set forth above teaches to provide functional graphics on the mineral fiber material, it would have been a matter of obvious design choice to have provided any specific such design meeting the disclosed function motivated by the desire to provide a user with convenient instructions or improved product aesthetics.

(12) Response to Arguments

In response to Appellant's treatment of the prior art rejections:

The Examiner believes Applicant may be misapplying the fact situation set forth in *In re Miller*, 164 USP 46 (CCPA 1969) to the instantaneous circumstances. The court, in that case stated as follows:

As for the examiner's characterization of the indicia and legend as "unpatentable printed matter," we note that the examiner himself recognized the fact that printed matter can be given "patentable weight." He did so in allowing claims. His characterization of printed matter as "unpatentable" is beside the point; no attempt is here being made to patent printed matter as such. The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to the

combination. Here is a new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating the ratio, and in our judgment the appeal claims properly define this relationship.

In re Miller implicitly sets forth the following requirements to be met by the examiner when making rejections of printed articles:

1. Prior art combination must yield Applicant's article structure.
2. Prior art taken alone or in combination with other prior art must disclose indicia on said article.
3. Indicia must conceptually serve the same purpose as Applicant claims be it decorative or functional.

What is seemingly not required by the Miller analysis is for the specific graphical design to be explicitly provided for in the prior art. Applicant states that measuring cups with markings had existed prior to the invention of the measuring cups of *In re Miller*.

Applicant adds that it was known to make measuring cups with printed indicia thereon. Applicant concludes by saying that by the present Examiner's reasoning, this prior art would have prevented the applicant in the *In re Miller* case from ever obtaining a patent. It is believed that the Applicant misunderstands the Examiner's reasoning in showing that the novelty of the indicia in *In Re Miller's* case rests in the new and unobvious function that volumetric indicia on a measuring cup serves. Whereas prior art measuring cups functioned by indicating the amount of material present after the whole volume of said measuring cup is full, the disputed measuring cup/receptacle of *In Re Miller* functions by indicating amounts of material present that are a fraction or ratio of the total

volume of said measuring cup/receptacle. The courts recognize that such indicia serves to improve a cook's ability to make fractionated recipes: something the prior art had not contemplated.

The Examiner has not summarily dismissed the requirement of prior art articles to have functional indicia thereon. The Examiner has given weight to the fact that functional indicia is present. The relied upon prior art clearly describes and illustrates a known and obvious functional relationship between mineral wool mats and instructive/functional indicia. In fact, the Applicant does not dispute that the indicia of Applicant's article functions identically to that disclosed by the relied on prior art. Had the applied prior art not anticipated this functional relationship instantly claimed, the Examiner would agree that the current rejections fail. For the above reasons, it is believed that the rejections should be maintained.

Respectfully submitted,



TERREL MORRIS
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Alexis Wachtel
Examiner
September 29, 2003

Appeal Conferees
Cynthia Kelly 
Terrel Morris - 